

REMARKS

Support for the amendment to paragraph [0005] may be found in original claim 1. Applicants respectfully suggest that new matter has not been added.

Claim rejections under 35 U.S.C. 112, second paragraph

The Office Action at page 2 indicates that claims 1-14 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejections. Reconsideration and withdrawal of the rejections are respectfully requested in view of the amendments and remarks.

The Office Action at page 2 indicates that Applicants' recitation of the term "usual auxiliaries" is confusing as to intent because it cannot be determined what is a usual versus a non-usual auxiliary. Applicants respectfully suggest that the rejection of claims 1-14 has been rendered moot in view of Applicants' amendment of claims 1, 8, and 12 deleting the phrase "usual".

The Office Action at page 2 indicates that claims 3, 4, and 6 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejections. Reconsideration and withdrawal of the rejections are respectfully requested in view of the amendments and remarks.

The Office Action at page 2 indicates that Applicants' ranges of %wt values have no recitation as to what they are based upon and are, accordingly, confusing as to intent. Applicants respectfully suggest that the rejection of claims 3, 4, and 6 has been rendered moot in view of Applicants' amendment of claims 3, 4, and 6 indicating that the ranges of %wt values are based upon the "polyol formulation" (claims 3 and 4) and the "polymer-modified polyol" (claim 6).

Claim rejections under 35 U.S.C. 102(b) as being anticipated by Watson

Claims 1-14 have been rejected under 35 U.S.C. 102(b) as being anticipated by Watson, Jr. et al. ("Watson") (U.S. Patent No. 4,816,494). Applicants respectfully traverse the rejections. Reconsideration and withdrawal of the rejections are respectfully requested in view of the amendments and remarks.

Anticipation requires that a reference teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142.

The Office Action at page 3 indicates that Watson discloses preparations of polyurethane foams from combinations of polymer-modified polyols including those claimed by applicants, blowing agents and catalysts as claimed by applicants, and other additives and reactants which are combined with isocyanates at indices as defined by applicants' claims (the Office Action indicates Watson column 3, line 30 - column 5, line 21, column 5, line 53 - column 7, line 23, and the examples, as well as, the entire document). Applicants respectfully traverse the Office Action statements.

Applicants respectfully suggest that Watson column 3, lines 30-38, discloses the preparing of the Watson polyurethane foam formulation and that it is essential that the polyol portion of the formulation consists of a mixture of (1) a polymer-polyol or graft-polyol composition and (2) a high molecular weight base polyol, i.e., having a molecular weight of at least 4500. Watson column 3, line 67 - column 4, line 5, discloses that the polymer-polyols or graft-polyols utilized in the Watson invention

may be of several types, including the vinyl-type or the step-growth polymerization types.

In all of the Watson Examples at columns 8-10, Carpol Polyol GP-6500 was used. The footnote to the Watson ingredients table at Watson Example 1, column 8, lines 11-30, indicates that Carpol Polyol GP-6500 is a high molecular weight glycerine-initiated polyether polyol. Applicants respectfully suggest that the Carpol Polyol GP-6500 would most likely correspond to the base polyol referred to in Watson under item (2) of a high molecular weight base polyol, i.e., having a molecular weight of at least 4500.

Further, in all of the Watson Examples, the polyol mixture contains, in addition to the base polyol, only one kind of polymer-polyol. In Watson Examples 1-14, Niax Polyol 34-28 was used. The footnote to the Watson ingredients table at Watson Example 1, column 8, lines 11-30, indicates that Niax Polyol 34-28 is a stable dispersion of a poly (styrene-co-acrylonitrile) polymer in a polyether polyol. In Watson Examples 15 and 16, the Niax Polyol 34-28 was replaced by a different kind of polymer-polyol, Multanol Polyol E-9225. The footnote to Watson Table IV, column 10, lines 1-25, indicates that Multanol Polyol E-9225 is a high molecular weight polyether polyol containing a polyurea dispersion.

Applicants respectfully suggest that Applicants' claimed combination of two polymer-modified polyols, (a) and (b), distinguishes over Watson. Applicants respectfully suggest that Watson may not anticipate, disclose, or suggest Applicants' claimed invention.

Claim rejections under 35 U.S.C. 103(a) as being unpatentable over Watson

Claims 1-14 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Jr. et al. ("Watson") (U.S. Patent No. 4,816,494). Applicants respectfully traverse the rejections. Reconsideration and withdrawal of the rejections are respectfully requested in view of the amendments and remarks.

Anticipation requires that a reference teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal*

Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142.

The Office Action, in the paragraph bridging pages 3 and 4, indicates that Watson discloses preparations of polyurethane foams from combinations of polymer-modified polyols including those claimed by applicants, blowing agents and catalysts as claimed by applicants, and other additives and reactants which are combined with isocyanates at indices as defined by applicants' claims (the Office Action indicates Watson column 3, line 30 - column 5, line 21, column 5, line 53 - column 7, line 23, and the examples, as well as, the entire document).

The Office Action at page 4 further indicates that Watson differs from Applicants' claims in that Watson does not particularly require combinations of polymer modified polyols as claimed. However, Watson does disclose employment of each of the claim selected polymer-polyols as being acceptable for the purpose of achieving the enhanced cushioning properties desired. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed combinations of the recited polymer polyols of Watson in the preparations of Watson for the purpose of providing enhanced cushioning effects in products derived therefrom in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Applicants respectfully traverse the Office Action statements.

The Office Action at page 4 further indicates that it is *prima facie* obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable

circumstances. *In re Ruff* 118 USPQ 343; *In re Jezel* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532.

Applicants have discussed Watson hereinabove and incorporate such discussion herein at this point by reference.

Applicants respectfully suggest that the Watson Summary of the Invention, at column 3, lines 1-26, and Watson claim 1 disclose a densified polyurethane foam having enhanced cushioning properties and having a unique and superior feeling of comfort resulting from a soft touch yet with a deep firm support with an appropriate springiness to the foam. Applicants respectfully suggest that there is no motivation to modify Watson to use a combination of different polymer-modified polyols because the Watson Examples demonstrate that by using only one kind of Watson polymer-modified polyol, in addition to the Watson base polyol, the Watson densified polyurethane foam can be obtained.

Further, Applicants' specification at paragraph [0018] at page 8, line 29 - page 9, line 2, discloses that it has been found possible to reliably prepare high resilience foam having a relatively low compression set, more specifically a relatively low wet compression set, utilizing Applicants' formulations. Applicants' specification at paragraph [0040] at page 14, lines 28-34, discloses that a lower compression set indicates a more durable foam. Applicants' specification at paragraph [0004] at page 1, line 32 - page 2, line 2, discloses that the wet compression set is a measure for the durability of a foam in humid conditions. Applicants have discovered that these properties can be obtained by using a formulation comprising a combination of Applicants' polymer-modified polyols (a) and (b). Applicants respectfully suggest that Watson does not provide any suggestion or motivation for a skilled person that Applicants' combination would provide for Applicants' high resilience foam having a relatively low compression set, more specifically a relatively low wet compression set. Applicants respectfully suggest that there is no suggestion or motivation to modify Watson to arrive at Applicants' claimed invention.

Applicants also respectfully suggest that the results disclosed in Applicants' Examples further demonstrate the unobviousness of Applicants' claimed invention. Applicants' Table 2 at page 16 of Applicants' specification indicates that an example

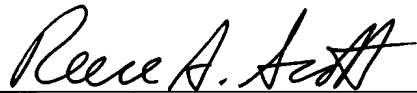
embodiment (Example 2) provided for a foam having a combination of a relatively high resilience and low wet compression set compared to Comparative Examples 2A and 2B.

CONCLUSION

Applicants respectfully request reconsideration and withdrawal of the claim rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 102(b), and 35 U.S.C. 103(a). Applicants further respectfully request entry and consideration of the above amendments and remarks to advance the above-identified application to allowance.

Respectfully submitted,

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